

Serial No. 09/656,289 filed Sept. 6, 2000
Amendment of September 8, 2003
in Response to Office Action of March 7, 2003

Remarks

Receipt is acknowledged of the Office Action dated March 7, 2003 in the above-captioned matter. Reconsideration of the application and a three-month extension of the time provided for response are respectfully requested. The Commissioner is hereby authorized to debit any fees that may be required from Deposit Account No. 50-1604, including, but not limited to the fees for the extension and the new claims, and is further authorized to credit any overpayments thereto.

The present application claims the priority of U.S. Provisional Application Serial No. 60/152,655 filed September 7, 1999, as set forth on the first page of the specification and in the declaration. However, the texts of the Office Actions to date have referred only to applicant's prior design patents, but not to the provisional application. As a result, it would be appreciated if acknowledgment could be provided of the priority claim to the provisional application with entry of that priority claim into the file.

In the Office Action, the Examiner rejected the application under §102(a) based on the Shefflin reference. In response to the rejection, the pending claims have been amended as set forth above. Reconsideration of the rejections is respectfully requested.

As set forth in the amended claims, claim 1 recites a cover having a button at the top of the cover, the button being a sealing element which is integrated into the cover. This invention is not taught or suggested in the Shefflin reference. As recited in Shefflin, the lid 43 is not integrated into the overcap 18. Rather, lid 43 is detachable from the overcap, and can be opened and closed. See e.g., Figure 2a and col. 6 lines 5 - 28.

In contrast to the Shefflin reference, the button of the presently amended claims is an integrated

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sealing element, the button being attached to the cover such that they are united into a whole. In other words, the button (icon) of the amended claims is not intended to be detachable by the user during use. This is unlike the Shefflin reference, and ensures the non-spill aspects of the cover.

Moreover, as recited in the amended claims, in accordance with the invention, liquid cannot emerge from the nipple into the surrounding environment (e.g. the floor, a caregiver's clothing, etc.) while said cover is attached to the baby bottle. In Shefflin, in contrast, liquid can emerge from the nipple while the cover is attached. In Shefflin, if a baby were to shake the bottle of Figure 2a while the cover is attached to the bottle, liquid will spill onto the surrounding environment. Thus, in Shefflin, liquid can spill out of the cover, which is contrary to the objectives of the present invention and contrary to the limitations of the amended claims.

In accordance with the invention of the amended claims, no liquid can spill out of the nipple while the cover is attached to the baby bottle. The cover is specifically designed to achieve this objective. The button prevents spilling of liquid out of the cover at all times while the cover is attached to the bottle. Due to the fact that the present invention is provided to minimize or eliminate spillage, this is an important advantage achieved by the present invention.

Shefflin does not teach or suggest this invention. On the contrary, Shefflin indicates that the "the disadvantage of conventional overcaps is that they must be removed entirely from the bottle to expose the nipple for use." *See*, col 1, lines 37-39. Thus, not only does Shefflin not disclose the present invention, it teaches away from the present invention. The present invention requires that the entire cover be removed from the bottle to drink from the nipple. Since the button is integrated into the cover the present invention provides that the entire cover must be removed from the bottle to expose the

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nipple for use. This is the opposite of what is taught in Shefflin.

As an aside, it should be noted that the button can be of any desired shape, provided that the button meets the limitations of the claims above. Various specific configurations for the button are recited in the dependent claims (see e.g. claim 4) and the independent claims (see e.g. claim 16).

With respect to the availability of the Shefflin reference as prior art under 102(a), it is still believed that the reference is unavailable based on the information provided to date. For the reference to be available as of the date of its abandoned parent application, it must be shown that the parent application discloses the particular subject matter in question. However, the issued Shefflin patent is a continuation-in-part application of another continuation-in-part application of another continuation-in-part application, and therefore the parent applications do not have the same amount of disclosure as set forth in the issued patent. The grandparent application – which has less subject matter than the issued grandchild – is being cited using the text of the grandchild application, without a showing that the cited disclosure in the grandchild is also in that grandparent. The quotation from MPEP 901.02 cited in the Office Action, only further confirms that this showing must be made (see the last section set forth in bold, which sets forth the requirement that the subject matter being cited must be common to both the patent and the abandoned parent application). A copy of the cited parent reference would, therefore, have to be provided to show whether or not any disclosure which is cited against the present application is present in the parent application as of the cited date. Likewise, the first bold section is not applicable since it refers to abandoned applications previously published under 35 U.S.C. §122(b), but the parent abandoned applications could not have been published under that provision. The publication provision under §122(b) was enacted as part of the American Inventors' Protection Act of

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1999, which became effective on November 29, 2000, and therefore does not apply to the applications being cited herein which were all filed before that date. See e.g. 37 C.F.R. §1.211 (whose effective date is November 29, 2000).

In any event, the availability of the Shefflin reference as art is believed to no longer be relevant in view of the amendments to the claims set forth above.

With respect to the remaining references, none of the remaining references are believed to teach or suggest the limitations of the amended claims. Held does not teach an integrated button which serves as a sealing element, nor do the remaining references teach that limitation. Nor are the other limitations of the amended claims taught or suggested. For example, the limitations of claims 16, 51, 52 and their dependent claims are also not taught or suggested in the cited references.

In view of the above, it is believed that the amended claims are all fully patentable over the art of record. Favorable action on the application and allowance of the pending claims is respectfully requested and believed fully warranted.

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Respectfully submitted,



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